

REMARKS

Claims 1-33 are pending. In the Final Office Action mailed April 10, 2008 ("OA"), the Examiner rejected claims 1-33. Further, the Examiner maintained the rejection in an Advisory Action mailed June 26, 2008. With this response, Applicants amend claims 19, 21, 22, 26, 28, and 29 for clarification purposes only and add new claim 34. Applicants respectfully traverse the rejections and request reconsideration based on the following remarks.

In addition, Applicants do not necessarily agree with or acquiesce to the Examiner's characterization of the claims or the prior art, even if those characterizations are not addressed herein.

Response to Arguments Presented in Advisory Action

The Examiner stated "[m]odifying the budgeting system of Haines to budget for human resources would not change its principle operation, as the system would still be allocating and monitoring a budget. The modification would merely be applying a known technique to a known method ready for improvement to yield predictable results with an expectation of success." Applicants respectfully request that the Examiner reconsider.

Haines is only capable of analyzing and budgeting for a consumer only—not an entire department. Haines at page 16, paragraph 0136 (hereinafter notated as 16:0136). Haines is set up to help a consumer purchase only listed items over a period of time—not budget for everything associated with the operation and structure of a department. Budgeting for a department is significantly more complex than budgeting

for a single person because it involves allocating for resources outside of purchasing listed items, such as, for example, incoming and outgoing employees, changing employee benefits, stock option purchasing, insurance, etc. Accordingly, Haines is not capable of budgeting for a wide array of resources for an entire department because it only budgets for listed items for a specific customer. For the Examiner to indicate that Haines is capable of being modified to include setting up a human resource budget for an entire department, when Haines only discloses budgeting for a listed item, is grossly misrepresenting the capability of Haines.

Further, the Examiner stated "[Applicants] further [argue] that one of ordinary skill in the art would have no reason to make the combination since a consumer would have no reason to monitor a human resource budget. *A recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim*" (emphasis added). The Examiner appears to paraphrase the italicized portion above from MPEP § 2111.02 (II), titled "Preamble Statements Reciting Purpose or Intended Use," which states:

During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference (or, in the case of process claims, manipulative difference) between the claimed invention and the prior art. If so, the recitation serves to limit the claim. See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. Court held that the intended use of hair curling was of no significance to the structure and process of making.); *In re Siney*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim did not distinguish over the prior art apparatus).

If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (anticipation rejection affirmed based on Board's factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant's claim 1 (a dispensing top for dispensing popcorn in a specified manner)) and cases cited therein. See also MPEP § 2112 - § 2112.02.

MPEP § 2111.02 (II) (emphasis added).

In other words, the Examiner appeared to rely on this section when rejecting the claims. But this section is related to recitations to the preamble—not the claim elements themselves, as purported by the Examiner—so the Examiner's rejection appears to be in error. Further, as stated above, Haines is not capable of budgeting for a wide array of resources for an entire department because it only budgets for listed items for a specific customer. Therefore, Applicants respectfully request that the Examiner reconsider the rejection.

Amendments to the Claims

Applicants amend claims 19, 21, 22, 26, 28, and 29 to correct the dependencies of these claims. In the Response dated December 21, 2007, these claims were inadvertently updated to depend on the wrong claims. With this response, Applicants amend the claims to reflect their original dependencies.

Because the Examiner's rejection appears to be based on the original dependencies of claims 19, 21, 22, 26, 28, and 29, Applicants respectfully submit that the Examiner would not have to conduct a new search according to these amendments.

Claim Rejections under 35 U.S.C. §103

Claims 1, 2, 4, 6-10, and 13-33

The Examiner rejected claims 1, 2, 4, 6-10, and 13-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2003/0033211 ("Haines") in view of U.S. Patent No. 6,026,390 ("Ross"). Applicants respectfully traverse the rejection.

When making a determination of obviousness, the Examiner must (1) determine the scope and content of the prior art, (2) ascertain the differences between the claimed invention and the prior art, and (3) resolve the level of ordinary skill in the pertinent art. MPEP § 2141 (II), 8th Ed., Rev. 6 (Sept. 2007) (citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966)). According to this section, "[a]scertaining the differences between the claimed invention and the prior art requires interpreting the claim language, see MPEP § 2111, and considering both the invention and the prior art as a whole." MPEP § 2141 (II)(B) (emphasis added). Further, the MPEP requires the Examiner to consider the claims as a whole by reciting "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP 2141.02 (I) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983)).

When an Examiner evaluates the references, according to MPEP § 2141.02 (VI), "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP § 2141.02 (VI) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)). Further, MPEP § 2143.01 (VI) recites "[i]f the proposed

modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01 (VI) (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)) (emphasis added). Based on the MPEP and its supporting case law, Applicants respectfully request that the Examiner reconsider the rejection.

Claim 1 recites "[a] position budgeting and control system for evaluating and controlling human resource budgets, comprising: ... at least one data base containing human resource data relating to human resource objects; and a commitment engine, said commitment engine retrieving human resource data from said at least one data base and evaluating a human resource budget for a given human resource object for a predefined period of time based on said retrieved human resource data, said commitment engine further storing a result of said evaluation, monitoring said human resource budget during said predefined period of time, and providing an automatic notification to a user based on said monitoring" (emphasis added). Applicants respectfully submit that the cited prior art fails to render claim 1 as obvious.

Haines is directed to a purchase incentive program that involves manufacturers, retailers, and consumers. Haines at 1:0002. This purchase incentive program allows for manufacturers to match their item identifiers with the identifiers of the retailer's corresponding items. *Id.* This allows manufacturers to track and analyze consumer purchases. *Id.* at 1:0006. Further, the purchase incentive program provides consumers of these items with the ability to analyze and budget for the consumer's intended purchases of only these listed items over a budget period. *Id.* at 16:0136.

To reject the claims, the Examiner used Haines analyzing and budgeting of consumer purchases of specific items to reject claim 1. OA at page 3-4. But the Examiner acknowledged that Haines fails to disclose analyzing and budgeting based on human resource data. *Id.* at 4. To overcome Haines's deficiencies, the Examiner used Ross for its disclosure concerning the need to budget for employees in a department.

But one of ordinary skill in the art would not have reason to combine Ross's budgeting for employees in a department into Haines's analyzing and budgeting of consumer purchases of specific products in order to render claim 1 obvious. First, incorporating Ross into Haines would destroy the purpose of Haines's purchase incentive program. Haines's purchase incentive program is designed to allow consumers the ability to budget for specific items, associated with manufacturers and retailers, located within the item database—not budget for everything associated with the operation and structure of a department. Budgeting for an entire department is significantly more complex than budgeting for a single person because it involves allocating for resources outside of purchasing specific items, such as incoming and outgoing employees, changing employee benefits, stock option purchasing, insurance, etc. By expanding Haines's simple consumer budgeting plan for only those listed items corresponding with specific retailers and manufacturers to now include Ross's much more sophisticated budgeting plan for an entire department would drastically exceed the scope of budgeting set forth in Haines.

Further, the Examiner's purported combination would be providing a consumer with the ability to monitor human resource data. This combination would appear to be counterintuitive because the consumer would only be concerned with his own

purchases and not for monitoring human resource data for a plurality of people within a department. Therefore, one of ordinary skill in the art would not have a reason to combine Ross into Haines to render claim 1 as obvious. Accordingly, Applicants respectfully submits that claim 1 is patentable over the cited art.

Claims 2, 4, 6-10, and 13-15 depend on claim 1 and are patentable for at least the same reasons as claim 1.

Independent claims 16 and 23 recite language similar to that of claim 1 and are patentable over the prior art for at least the same reasons as claim 1. Claims 17-22 and 24-29 depend on claims 16 and 23, respectively, and are patentable for at least the same reasons as claims 16 and 23.

Further, regarding claim 19, the Examiner appeared to reject this claim based on Haines providing language about a budget. OA at pages 7-8. But Haines in view of Ross fails to disclose or suggest "a pre-commitment step for occupied and vacant human resource positions." Neither of these references appears to comprehend at least this sort of pre-commitment step. For at least these reasons, Applicants respectfully submits that claim 19 is patentable over the cited art as well.

Claim 3

The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Haines in view of Ross, further in view of U.S. Patent No. 5,600,554 ("Williams"). Applicants respectfully traverse the rejection.

Claim 3 depends on independent claim 1. As shown in the analysis above, claim 1 is patentable over Haines in view of Ross. Williams fails to overcome the deficiencies

of Haines in view of Ross. Williams provides a computer software application for securing, integrating, and manipulating employee payroll and human resource information. But, like Ross above, one of ordinary skill in the art would not have a reason to combine Williams employee payroll applications into Haines's simple consumer budgeting plan for only those listed items corresponding with specific retailers and manufacturers. Therefore, Haines in view of Ross and Williams fails to disclose or suggest the features of independent claim 1. Because claim 3 depends on claim 1, claim 3 is patentable over the cited art for at least the same reasons as claim 1.

Claim 5

The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Haines in view of Ross, further in view of Official Notice. Applicants respectfully traverse the rejection.

Claim 5 depends on independent claim 1. As shown in the analysis above, claim 1 is patentable over Haines in view of Ross. The Official Notice fails to overcome the deficiencies of Haines in view of Ross because, at most, it only provides calculating an employee salary. Therefore, Haines in view of Ross and Official Notice fails to disclose or suggest the features of independent claim 1. Because claim 5 depends on claim 1, claim 5 is patentable over the cited art for at least the same reasons as claim 1.

Claims 11 and 12

The Examiner rejected claims 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Haines in view of Ross, further in view of Ruth E. Thaler-Carter,

"EMA Model Defines Cost-Per-Hire as Part of Staffing Performance", HRMagazine, Dec., 1997, Vol. 42, Iss. 12, Pg. 51-54 (hereinafter "Thaler-Carter"). Applicants respectfully traverse the rejection.

Claims 11 and 12 depend on independent claim 1. As shown in the analysis above, claim 1 is patentable over Haines in view of Ross. Thaler-Carter fails to overcome the deficiencies of Haines in view of Ross. Thaler-Carter discusses a model for defining a cost-per-hire for employee positions to achieve a "better common indicator of the productivity of the recruiting effort." Thaler-Carter at Abstract/Summary and page 51. But Thaler-Carter fails to overcome the deficiencies of Haines in view of Ross addressed above because one of ordinary skill in the art would not have a reason to combine Ross into Haines. Therefore, Haines in view of Ross and Thaler-Carter fails to disclose or suggest the features of independent claim 1. Because claims 11 and 12 depend on claim 1, claims 11 and 12 are patentable over the cited art for at least the same reasons as claim 1.

New Claim 34

New claim 34 recites "a central processing unit; input/output means; at least one database containing human resource data relating to human resource objects; and a commitment engine configured for retrieving human resource data from the at least one data base and evaluating a human resource budget for a given human resource object for a predefined period of time based on the retrieved human resource data including pre-commitment data concerning both vacant and occupied positions, the commitment engine further storing a result of the evaluation, monitoring the human resource budget

during the predefined period of time, and providing an automatic notification to a user based on the monitoring.” For at least the reasons set forth above, Applicants respectfully submit that claim 34 is patentable over the cited art.

Further, the cited references fail to disclose or suggest “a pre-commitment step for occupied and vacant human resource positions.” None of the cited references appear to comprehend the pre-commitment data concerning both vacant and occupied positions. For at least these reasons, Applicants respectfully submits that claim 34 is patentable over the cited art as well.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 10, 2008

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